

In re Patent Application of:

KASSER

Serial No. 10/799,371

Filed: **MARCH 13, 2004**

REMARKS

Applicant would like to thank the Examiner for the thorough examination of the present application. Applicant would also like to thank the Examiner for correctly indicating as allowable the subject matter of dependent Claims 3, 5, 6, 8, 11, 13, 15-16, 19, 21-24, 27-28 and 33-34. The arguments supporting patentability of the claims are provided below.

I. The Claimed Invention

The present invention, as recited in independent Claim 1, for example, is directed to a method for securing circulation of an encrypted digital document to be reproduced with a document reader. The method comprises providing a user with a storage device storing identification information identifying the storage device and for storing an identification information list comprising identification information identifying recent document readers previously operated with the storage device.

The method further comprises transmitting to a server over a digital data transmission network from the storage device to the server upon connection of the storage device to the server by a terminal connected to the digital data transmission network and to the storage device information identifying the digital document to be reproduced, and the information list and the identification information of the storage device.

The method further comprises identifying from the server the storage device on the basis of the information identifying of the storage device transmitted to the server. Possible fraudulent use of the storage device is determined based

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upon the information list that is transmitted to the server. The server compares the identification information in the information list with an authorized or fraudulent reader list for determining fraudulent use of the storage device. If the storage device is not being fraudulently used, then the method comprises transmitting over the digital data transmission network from the server to the computer terminal a decryption key specific to the digital document to be reproduced, with the decryption key being stored in the storage device. The digital document is decrypted using the stored decryption key by the document reader connected to the storage device. The digital document decrypted by the document reader is reproduced.

Independent Claim 9 is also directed to a method for securing circulation of an encrypted digital document to be reproduced with a document reader, and is similar to independent Claim 1.

Independent Claim 17 is directed to a system for securing circulation of an encrypted digital document to be reproduced with a document reader, and is similar to independent Claim 1.

Independent Claim 25 is also directed to a system for securing circulation of an encrypted digital document to be reproduced with a document reader, and is similar to independent Claim 1.

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II. The Claims Are Patentable

The Examiner rejected independent Claims 1, 9, 17 and 25 over the Harada et al. patent in view of the Chatani et al. published patent application.

Harada et al. is directed to a method for securing circulation of an encrypted digital document to be reproduced with a document reader. The Examiner cited Harada et al. as disclosing the claimed invention except for transmitting information identification to a server over the digital data transmission network from the storage device to the server upon connection of the storage device to the server by a terminal connected to the digital data transmission network and to the storage device; and identifying from the server the storage device on the basis of the information identification of the storage device transmitted to the server.

The Examiner referenced Chatani et al. as disclosing that server and computer systems transmit and receive data over a computer network or standard telephone line. The Examiner also noted that Harada et al. and Chatani et al. are analogous art because both teach securing distribution of encoded digital data/digital documents.

The Examiner has taken the position that it would have been obvious at the time of the invention to modify Harada et al. to include server and client computer systems that transmit and receive data over a computer network as in Chatani et al. because identification information is transmitted by the user to the server to generate the unlock key used by the user for further interpretation.

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The Applicant submits that even if the references were selectively combined as suggested by the Examiner, the claimed invention is still not produced. Harada et al. and Chatani et al. both fail to disclose that the server receives the identification information of the storage device.

Chatani et al. is directed to a product distribution and payment system for limited use or otherwise restricted digital software products. Digital content data comprising a software product to be rented is made available to customers through a detachable local storage medium, such as a DVD or CD-ROM disc, or over a network connection. The product digital content is capable of being accessed and played back through a computer or game console at the customer site. The software product may comprise a limited use product that is restricted in the number of plays or duration of use. The customer is allowed to download and purchase the product using their computer or playback console. The product purchase information is encoded and transmitted to the content distributor. When the preset time or number of plays has elapsed, the software program is frozen and access to the program is not allowed.

Consequently, Chatani et al. discloses a user purchasing a software product from a server, and then accessing and playing back the software product based on receiving the proper public/private keys. Chatani et al. fails to disclose 1) identifying from the server the storage device on the basis of the information identification of the storage device transmitted to the server; and 2) identifying from the server the storage device on the basis of the information identification of the

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storage device transmitted to the server; and 3) the server determining possible fraudulent use of the storage device based upon an authorized or fraudulent reader list of storage devices for determining fraudulent use of the storage device.

Instead, the received software product in Chatani et al. is a limited use product that is restricted in the number of plays or duration of use. When the preset time or number of plays has elapsed, the software program is frozen and access to the program is not allowed. With this being the case, there is simply no need in Chatani et al. to determine if the device playing the software product is an authorized storage device.

In sharp contrast, the information list in the claimed invention comprises identification information identifying recent document readers previously operated with the storage device, and the server compares the identification information in the information list with an authorized reader list for determining fraudulent use of the storage device.

Accordingly, it is submitted that independent Claim 1 is patentable over Harada et al. in view of Chatani et al. Independent Claims 9, 17 and 25 are similar to independent Claim 1. Therefore, it is submitted that these claims are also patentable over Harada et al. in view of Chatani et al.

In view of the patentability of independent Claims 1, 9, 17 and 25, it is submitted that the other rejected dependent claims, which include yet further distinguishing features of the invention are also patentable. These dependent claims need no further discussion herein.

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III. CONCLUSION

In view of the arguments provided herein, it is submitted that all the claims are patentable. Accordingly, a Notice of Allowance is requested in due course. Should any minor informalities need to be addressed, the Examiner is encouraged to contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,



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